



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,488	01/15/1999	DONNA E. PRUNKARD	PPL-1REISSUE	1781
20350 7590 09/29/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CROUCH, DEBORAH				
ART UNIT		PAPER NUMBER		
1632				
MAIL DATE		DELIVERY MODE		
09/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/232,488

Applicant(s)

PRUNKARD ET AL.

Examiner

Deborah Crouch

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-13, 16, 17, 23-25 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 13, 16, 17 and 34 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-11 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's arguments filed July 22, 2010 have been fully considered but they are not persuasive. The improper broadening rejection made in the office action mailed April 22, 2010 is maintained, and a new improper broadening rejection has been made in this office action.

Non-Final Office Action:

This is a reissue of Patent No. 5,639,948: claims 1-33 issued June 17, 1997.

Status of the Claims:

Claims 1, 2, 5-13, 16, 17, 23-25 and 34 are currently pending and under consideration.

Claims 3-4, 14-15, 18-22 and 26-33 have been cancelled.

Claims 12, 13, 16, 17 and 34 are allowable.

Claims 1, 2, 5-11 and 23-25 are pending and are rejected below.

Withdrawn Rejections

The rejection of claims 1 and 23 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicant's arguments.

The rejection of claims 12, 13, 16 and 17 under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period is withdrawn. A review of the file reveals applicant filed claims containing the broader scope of promoter on April 1, 1999. Although these claims were not entered, the claims are deemed sufficient to indicate intent to broaden within the statutory period.

New Rejections:

Claims 1, 2, 5-11 and 23-25 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

Amendments to claims 1, 7 and 23 broadening the scope of fertilized egg in the allowed claims to the generic term egg were filed August 6, 2007. This amendment was filed more than 2 years after the filing of this reissue application.

The declaration filed January 15, 1999 does not indicate an intent to broaden the scope of "fertilized egg" in claims 1, 7 and 23 to "egg" or as delete "fertilized" an error to be corrected by this reissue. Applicant is only permitted to broaden a claim consistent with the declaration and intent to broaden as indicated within the two year deadline. See MPEP 1412.03. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

There is no evidence on this record that applicant intended to broaden the scope of fertilized egg to egg.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch whose telephone number is (571)272-0727. The examiner can normally be reached on M-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Crouch/
Primary Examiner, Art Unit 1632

September 27, 2010